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U.S. DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA
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8 **UNITED STATES DISTRICT COURT**
9 **SOUTHERN DISTRICT OF CALIFORNIA**

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11 ISIS PHARMACEUTICALS, INC.,
12 Plaintiff,
13 vs.
14 SANTARIS PHARMA A/S CORP. et al.,
15 Defendant.
16

CASE NO. 11cv2214-GPC (KSC)
**ORDER DETERMINING
DISCOVERY DISPUTE RE:
DEFENDANTS' FIRST SET
OF INTERROGATORIES:
NOS. 1, 4, 7**
[Doc. Nos. 145, 161]

17 Before the Court is the parties' Joint Motion for Determination of Discovery
18 Dispute [Doc. No. 145 (unsealed), Doc. No. 161 (sealed)] regarding plaintiff's
19 responses to defendants' First Set of Interrogatories. Specifically, defendants contend
20 that plaintiff failed to provide adequate responses to Interrogatory Nos. 1, 4, and 7, and
21 seek an order from the Court compelling plaintiff to provide additional responses. For
22 the reasons outlined below, defendants' request for additional responses from plaintiff
23 is **GRANTED in part** and **DENIED in part**.

24 **I. BACKGROUND**

25 On September 22, 2011, plaintiff Isis Pharmaceuticals ("Isis" or "plaintiff") filed
26 a Complaint [Doc. No. 1] alleging that defendants Santaris Pharma A/S Corp. and
27 Santaris Pharma A/S (collectively, "Santaris" or "defendants") have infringed upon two
28 of plaintiff's patents. The two patents at issue in this litigation involve a form of

1 biotechnology called antisense molecules. Antisense molecules are generally used to
2 interrupt the overproduction or abnormal production of certain proteins that can cause
3 disease. On January 30, 2012, defendants filed a Motion for Summary Judgment
4 arguing that their allegedly infringing activities were protected by the “Safe Harbor”
5 provision of 35 U.S.C. § 271(e)(1). [Doc. No. 17] On July 26, 2012, the Court entered
6 a Case Management Conference Order Regulating Discovery and Other Pretrial
7 Proceedings in a Patent Case. [Doc. No. 42] The case progressed until September
8 2012, when the normal flow of discovery was interrupted by an intervening Court
9 Order.

10 Specifically, on September 18, 2012, Judge Moskowitz issued an Order Denying
11 Defendants’ January 30, 2012 Motion for Summary Judgment (“MSJ”) without
12 prejudice [Doc. No. 53], finding that (1) defendants *could* fall within the Safe Harbor
13 but that it is a fact-intensive inquiry and more substantial fact discovery was required;
14 and, (2) the Safe Harbor issue could potentially dispense of the entire case. Judge
15 Moskowitz established a 120-day period of limited discovery related solely to
16 defendants’ Safe Harbor defense, and gave defendants leave to re-file their MSJ (on the
17 issue of Safe Harbor only) within 30 days of the close of this limited discovery period.
18 [Doc. No. 53] The following day, Judge Moskowitz issued an Order staying discovery
19 related to everything except defendants’ Safe Harbor defense, allowing only Safe
20 Harbor related discovery to occur during the 120-day period. [Doc. No. 54] The 120-
21 day period of limited discovery contemplated by the Judge Moskowitz was September
22 18, 2012 to January 16, 2013. Further, the original 30-day leave granted for defendants
23 to re-file their Safe Harbor MSJ expired on February 15, 2013.

24 This matter was transferred from District Judge Moskowitz to District Judge
25 Curiel on October 12, 2012. [Doc. No. 57] On November 30, 2012, plaintiff filed an
26 *ex parte* Motion [Doc. No. 62] asking the Court to vacate the remaining period of
27 limited discovery so that discovery on all issues could re-commence, and to extend the
28 filing deadline for defendants’ renewed MSJ on the Safe Harbor issue. Plaintiff

1 claimed that, contrary to the representations made to Judge Moskowitz, discovery on
2 the Safe Harbor issue was not narrow or isolated from the other issues and was much
3 more complicated and fact-intensive than represented. On December 10, 2012,
4 defendants filed an Opposition [Doc. No. 67], explaining that the Safe Harbor issue
5 was more discrete than represented by plaintiff and that defendants' voluminous (and
6 reluctant) discovery production (exceeding the scope of Safe Harbor) was at plaintiff's
7 request and stemmed from defendants' desire to avoid future costly discovery disputes.
8 Accordingly, defendants requested a hearing before Magistrate Judge Crawford to
9 address plaintiff's requests.

10 On January 15, 2013, the Court held a Discovery Hearing to address the issues
11 raised. [Doc. No. 101] Specifically, the Court heard oral argument regarding the
12 deadline for filing a renewed MSJ on the Safe Harbor issue and the appropriate scope
13 of discovery leading up to said filing. On January 31, 2013, based on the arguments
14 presented at the January 15, 2013 Discovery Hearing, the Court ordered, *inter alia*,
15 "The current discovery stay limiting discovery to the Safe Harbor issue *only* (35 U.S.C.
16 § 271(e)(1)) will remain in place until **April 5, 2013**. Parties are not authorized to
17 engage in discovery related to any other areas, including 35 U.S.C. § 271(a), before
18 April 5, 2013. No discovery encompassing a broader range of issues is to commence
19 absent further order of Court." [Doc. No. 94, p. 2 (emphasis in original)]

20 On March 8, 2013, the parties submitted a Joint Motion for Resolution of
21 Dispute [Doc. No. 113] concerning plaintiff's proposed testifying expert, Dr. Nicholas
22 M. Dean. Defendants notified the Court that this pending dispute was impacting their
23 ability to file their renewed MSJ on the Safe Harbor issue. Accordingly, on April 26,
24 2013, District Judge Curiel set a telephonic status hearing for May 3, 2013 "to discuss
25 an appropriate hearing date and briefing schedule for [d]efendants' renewed summary
26 judgment motion." [Doc. No. 131, p. 2] As a result of the May 3, 2013 telephonic
27 hearing, Judge Curiel amended the filing deadline and briefing schedule for
28 defendants' renewed MSJ. [Doc. No. 132]

1 On May 6, 2013, a Discovery Hearing was held [Doc. No. 134] before
2 Magistrate Judge Crawford to hear argument regarding the parties' dispute over
3 plaintiff's expert, Dr. Dean. After considering the arguments, on May 17, 2013, the
4 Court ordered plaintiff to disclose certain information about Dr. Dean's consulting
5 practice and further instructed the parties to timely contact the Court if they remained
6 unable to resolve their conflict after the required information was disclosed. [Doc. No.
7 140] After the production by plaintiff of the required information, defendants'
8 objections remained and, on June 10, 2013, the parties filed a Supplemental Joint
9 Motion for Resolution of Dispute over Dr. Dean. [Doc. No. 149 (unsealed), Doc. No.
10 162 (sealed)] In addition, on June 7, 2013, the parties filed the instant Joint Motion for
11 Determination of Discovery Dispute [Doc. No. 145 (unsealed), Doc. No. 161 (sealed)]
12 regarding plaintiff's responses to defendants' First Set of Interrogatories. The parties
13 again notified the Court that these pending discovery disputes were impacting their
14 ability to proceed with the renewed MSJ. [Doc. No. 155, Joint Motion seeking
15 expedited review of discovery disputes]

16 II. DISCUSSION

17 The scope of discovery under Rule 26(b) is broad: "[p]arties may obtain
18 discovery regarding any matter, not privileged, which is relevant to the claim or
19 defense of any party involved in the pending action. Relevant information need not
20 be admissible at trial if the discovery appears reasonably calculated to lead to the
21 discovery of admissible evidence." FED.R.CIV.P. 26(b). However, a court may
22 limit discovery of relevant material if it determines that the discovery sought is
23 unreasonably cumulative or duplicative, or obtainable from some other source that
24 is more convenient, less burdensome, or less expensive, or the burden or expense of
25 responding to the proposed discovery outweighs the likely benefit. The party
26 resisting discovery generally bears the burden of showing that the discovery
27 requested is irrelevant to the issues in the case or is overly broad, unduly
28 burdensome, unreasonable, or oppressive. If the resisting party meets its burden,

1 the burden shifts to the moving party to show the information is relevant and
2 necessary. *Henderson v. Holiday CVS, L.L.C.*, 269 F.R.D. 682, 686 (2010).

3 **A. Defendants' First Set of Interrogatories**

4 Defendants contend that plaintiff failed to provide adequate responses to
5 Interrogatory Nos. 1, 4, and 7. For the reasons articulated below, the Court finds
6 plaintiff is not required to supplement its responses to Interrogatory No. 1, but must
7 provide additional responses to Interrogatory Nos. 4 and 7.

8 **1. Interrogatory No. 1**

9 Interrogatory No. 1 asked plaintiff to identify and describe all of defendants'
10 allegedly infringing acts, including the identification of the country where those acts
11 occurred. [Doc. No. 161, p. 6] The description was to include the date, geographic
12 location, and a statement labeling the infringing act as a sale, offer to sell, use, or
13 importation. *Id.* Plaintiff objected to this interrogatory, arguing this request seeks
14 information outside the scope of the Safe Harbor provision and potentially seeks
15 information protected from disclosure by the attorney work product doctrine. *Id.* at
16 6-7. Subject to these objections, plaintiff responded by referring defendants to the
17 description of events contained in plaintiff's Complaint and Preliminary
18 Infringement Contentions. *Id.* In a supplemental response, plaintiff stated that one
19 or more of these acts occurred in the United States, citing specific, Bates-numbered
20 contracts as examples of unauthorized "sales" and, as an example of unauthorized
21 "use," that defendants, "at a minimum," performed patented methods at the Seattle,
22 Washington facility of one of defendants' partners. *Id.* at 8-9.

23 Plaintiff contends that "these infringing offers for sale and resulting sales
24 occurred 'in the United States,' as evidenced by at least (i) the terms of the various
25 contracts, (ii) the physical location of the personnel and entities involved in the
26 business negotiations in the United States, (iii) the physical location of
27 [defendants'] contract negotiations over a period of time in the United States, and
28 (iv) the physical location of the resulting performance of the contracting parties . . .

1 pursuant to commercial sales embodied in the contracts and their associated
 2 amendments, modifications, and addenda.” *Id.* at 9-10. As support for these
 3 contentions, plaintiff lists hundreds of Bates-numbered documents. *Id.* at 10-25.
 4 To the extent “place of performance” is relevant, plaintiff contends that the
 5 thousands of pages of details cited provide defendants with the information sought.
 6 *Id.* at 31.

7 Defendants argue that plaintiff should be compelled to provide further
 8 responses as to specific geographic locations because a “significant fact related to
 9 ‘use’ is where the allegedly infringing compounds, methods, and processes were
 10 used.” *Id.* at 25. Defendants contend that the plain language of the Safe Harbor
 11 provision itself exempts acts only “within the United States.” *Id.* Further,
 12 defendants argue that plaintiff’s own actions, i.e. asking defendants and witnesses in
 13 discovery requests and depositions to identify “where” certain work was performed,
 14 demonstrate the geographical relevance. *Id.* Defendants state that plaintiff has only
 15 revealed the exact geographic location of one alleged act of infringement and asks
 16 the Court to compel plaintiff to do so with regard to all alleged acts. For the reasons
 17 set forth below, the Court **DENIES** defendants’ request to compel plaintiff to
 18 provide additional responses to Interrogatory No. 1.

19 Since opening a period of limited discovery on the Safe Harbor issue and
 20 staying discovery on all other issues, the Court has repeatedly made clear its
 21 intention of keeping discovery limited solely to the issues raised by 35 U.S.C. §
 22 271(e)(1), not 271(a), pending resolution of defendants’ renewed summary
 23 judgment motion on the Safe Harbor issue.¹ The parties’ dispute over the specific
 24

25 ¹ Section 271(a) states in pertinent part, “Except as otherwise provided in this
 26 title, whoever without authority makes, uses, offers to sell, or sells any patented
 27 invention, within the United States or imports into the United States any patented
 28 invention, during the term of the patent therefor, infringes the patent.” 35 U.S.C. §
 271(a). Section 271(e)(1) (the Safe Harbor Provision), a provision contained “within
 the same title,” states in pertinent part, “It shall not be an act of infringement to make,
 use, offer to sell, or sell within the United States or import into the United States a
 patented invention . . . solely for uses reasonably related to the development and

1 geographical information sought in defendants' Interrogatory No. 1 is not essential
2 for defendants to prepare their renewed Safe Harbor MSJ. Plaintiff asserts in its
3 Complaint that defendants committed infringing acts under Section 271(a) within
4 the United States, and responded to Interrogatory No. 1 with pages of documents
5 "identif[ying] . . . contract documents showing where the place of performance
6 occurred . . ." [Doc. No. 162, p. 32] The Safe Harbor is an affirmative defense that
7 only excuses otherwise infringing activities that occurred in the United States. To
8 avail themselves of this defense, defendants must implicitly admit that they "ma[d]e,
9 use[d], offer[ed] to sell, or so[ld]" one of plaintiff's patented compounds or methods
10 within the United States. 35 U.S.C. § 271(e)(1). Otherwise, there would be no
11 conduct to be excused by the affirmative defense. While a Section 271(a)
12 infringement claim requires a *prima facie* showing that an infringing act occurred in
13 the United States, the assertion of the Safe Harbor defense assumes that the conduct
14 at issue occurred in the United States, but focuses on whether an otherwise unlawful
15 or infringing use of plaintiff's patented technology falls within 271(e)(1)'s Safe
16 Harbor, namely whether the use is "reasonably related to the development and
17 submission of information under a Federal law which regulates the manufacture,
18 use, or sale" of a drug. Accordingly, defendants' request seeking a Court order
19 compelling plaintiff to provide supplemental responses to Interrogatory No. 1 is
20 **DENIED.**

21 2. Interrogatory No. 4

22 Interrogatory No. 4 asked plaintiff to identify and describe all positions
23 advanced by or on behalf of plaintiff, or an entity related to plaintiff, regarding the
24 scope or application of the Safe Harbor provision as it relates to the '199 Patent
25 (one of the two patents at issue in this litigation). [Doc. No. 161, p. 33-34] The
26 description was to identify all communications with entities other than plaintiff or

27 _____
28 submission of information under a Federal law which regulates the manufacture, use,
or sale of drugs or veterinary biological products." 35 U.S.C. § 271(e)(1).

1 defendants where any party asserted that the activities alleged to come within the
2 scope of the '199 Patent fell under the Safe Harbor provision. *Id.* Plaintiff objected
3 to this interrogatory, arguing the request was vague, overbroad, duplicative, and
4 sought information protected from disclosure by the attorney-client privilege and
5 work product doctrine. *Id.* at 34. Subject to these objections, and pursuant to
6 Federal Rule of Civil Procedure 33(d), plaintiff responded by referring defendants
7 to numerous, already-produced Bates-numbered documents based on the results
8 yielded from the following mutually-agreeable search terms: "Safe Harbor",
9 "271(e)(1)", and "271e1". *Id.* at 34-45. In a supplemental response, plaintiff
10 directed defendants to numerous additional papers filed in this litigation, including
11 the declarations of Dr. Nicholas Dean and Dr. Elizabeth Gordon. *Id.* at 45.

12 In a further supplemental response, plaintiff explained the extent of its
13 involvement in two legal actions of interest to defendants, namely the 2012
14 *Alnylam*² case and the 2001-2002 *Sequitur*³ litigation. Regarding *Alnylam*, plaintiff
15 states that it was not the lead party in the litigation, the case was filed in January
16 2012 and dismissed in November 2012, and that plaintiff did not correspond
17 directly with Tekmira regarding the Safe Harbor provision. *Id.* at 46. Thus,
18 plaintiff is unaware of the existence of any non-privileged communications on the
19 topic, and claims that all other responsive documents are either publically available
20 or already in defendants' possession. *Id.* With respect to the *Sequitur* cases,
21 plaintiff claims it conducted extensive investigations regarding any correspondence
22 within the 2000-2001 time frame with Oasis, Hybridon, Genta, and other entities
23 involved in the litigation and did not find any additional responsive, non-privileged
24 information. *Id.*

25 Defendants argue that further responses should be compelled because the
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27 ² *Alnylam et al. v. Tekmira*, 12cv10087 (D. Mass. 2012).

28 ³ *Isis v. Sequitur, Inc.*, 01cv1223, 01cv2286, 02cv842 (C.D. Cal. 2001, 2002).

1 communications sought are relevant to the Safe Harbor issue. *Id.* at 47. Defendants
2 claim plaintiff has a history of aggressively enforcing its patents; thus, what plaintiff
3 has said and done in other cases involving the '199 Patent and the Safe Harbor
4 provision is relevant to this action because it may undermine or contradict
5 plaintiff's current contentions. *Id.* Specifically, defendants believe plaintiff sent
6 cease-and-desist letters to Oasis, Hybridon, Genta, and other entities involved in the
7 *Sequitur* cases. *Id.* at 48. These letters have not been produced. Furthermore,
8 defendants are not satisfied with plaintiff's application of the 3 search terms to the
9 electronically stored information, arguing that a key document⁴ was not produced
10 and many documents that were produced were irrelevant to this action.
11 Accordingly, defendants seek a Court order compelling plaintiff to conduct a
12 thorough search for such communications not limited by plaintiff's 2001-2001 time
13 frame. *Id.* Further, defendants seek assurances that no additional responsive
14 documents exist. *Id.*

15 Plaintiff argues it already provided detailed responses, that it has now twice
16 conducted "substantial" investigations at great time and expense regarding
17 communications in the *Sequitur* cases, that the communications, if any, are now
18 over 11 years old, and that defendants' demand for additional responses rests solely
19 upon defense counsel's speculation that such communications exist. *Id.* at 48-49.
20 Furthermore, plaintiff contends that defendants have already deposed 5 witnesses on
21 the topic and there is nothing left to discover. *Id.* at 49. According to plaintiff, "[I]t
22 is not that [plaintiff] has not complied; it is that Santaris does not like the answer."
23 *Id.*

24 Based on the arguments presented in the Joint Motion, the Court **GRANTS**

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26 ⁴ They key item cited by defendants which was not initially produced by plaintiff
27 in this case is a document written by plaintiff's CEO, Dr. Stanley Crooke, where Dr.
28 Crooke alluded to defendants' activities being protected by the Safe Harbor provision.
[Doc. No. 161, p. 47] Defendants argue that the absence of this document from
plaintiff's initial production both undercuts plaintiff's position in this lawsuit and casts
doubt upon the completeness of plaintiff's discovery responses in this litigation.

defendants' request to compel plaintiff to provide additional responses to Interrogatory No. 4. Interrogatory No. 4 contains no language limiting its request to the 2000-2001 time period. Accordingly, plaintiff's unilateral imposition of a temporal limitation on defendants' request was improper. Thus, to the extent responsive, non-privileged information exists from the time period of 2000 to present, it should be produced. Accordingly, **within 30 days** of issuance of this Order, plaintiff must conduct a thorough search and produce any non-privileged communications regarding the scope or application of the Safe Harbor provision as it relates to the '199 Patent. Also **within 30 days** of issuance of this Order, plaintiff must provide defendants with a certification in a sworn discovery response that the production represents the entire universe of responsive documents in plaintiff's custody. Specifically, plaintiff's representative must provide defendants with a written declaration under penalty of perjury detailing their efforts to locate the sought-after items and stating that "to the best of [his or her] knowledge, information, and belief formed after a reasonable inquiry," the responses to these requests are "complete and correct." FED.R.CIV.P. 26(g)(1)(A).

3. Interrogatory No. 7

Interrogatory No. 7 asked plaintiff to identify and describe each Investigational New Drug Application ("IND") and New Drug Application ("NDA") for an antisense oligonucleotide drug candidate submitted to the FDA by plaintiff or by one of plaintiff's "third party pharmaceutical partners" pursuant to "an agreement with [plaintiff]." [Doc. No. 161, p. 49] The description was to include the identities of plaintiff's employees most knowledgeable about the submissions of the INDs or NDAs, as well as communications with the FDA regarding the same. *Id.* Furthermore, the Interrogatory sought a statement as to "whether the IND or NDA contained any discussions or reports of in vitro tests of an antisense oligonucleotide and the purpose of any such tests." *Id.*

Plaintiff objected to this Interrogatory, claiming it seeks information outside

1 the scope the Safe Harbor provision, is vague, overbroad, and that the burden of
2 ascertaining the answer to all parts of the request will be substantially the same for
3 either party based on the documents already produced by plaintiff in this litigation.
4 *Id.* at 49-50. Subject to these objections, plaintiff responded by referring defendants
5 to certain Bates-numbered documents already produced, pursuant to Federal Rule of
6 Civil Procedure 33(d). *Id.* In a supplemental response, plaintiff identified
7 additional, already-produced documents, “which are the INDs and communications
8 thereon that [plaintiff] has produced in this action,” and cited that defendants have
9 already deposed the two Isis employees identified as signing these INDs. *Id.* In
10 addition, plaintiff described the two NDAs in its possession, custody, or control,
11 namely antisense drug compounds marketed under the brand names Vitravene and
12 Kynamro. *Id.* at 50-51. Vitravene, the lone NDA filed by plaintiff since its
13 inception, was approved by the FDA in 1998. *Id.* at 50. Kynamro was developed
14 by plaintiff’s partner, Genzyme, and was approved by the FDA in 2012. *Id.* at 51.
15 Plaintiff identified former Isis employee Mark Lotz as being the employee most
16 knowledgeable about the Vitravene NDA, and, to the extent plaintiff was consulted
17 by Genzyme regarding the Kynamro NDA, the Isis employees most directly
18 involved are Joseph Johnston and Dr. Brandt. *Id.*

19 Defendants argue that the information sought in this Interrogatory is directly
20 relevant to the Safe Harbor issue because these “INDs and NDAs provide examples
21 of the type information that [plaintiff] or others believe may be provided to the
22 FDA, and thus sheds light on whether [defendants’] allegedly infringing activities
23 include research that ‘if successful, would be appropriate to include in a submission
24 to the FDA.’” *Id.* at 52, citing *Merck KgaA v. Integra LifeSciences I, Ltd.*, 545 U.S.
25 193, 207 (2005). To that end, defendants seek a Court order compelling plaintiff to
26 produce the NDAs and to provide additional, sworn statements in formal discovery
27 responses regarding the completeness of the production of INDs and NDAs.

28 Regarding the INDs, it appears any substantive dispute has already been

1 resolved. However, defendants seek an unequivocal and binding statement from
 2 plaintiff (in a sworn discovery response, not in a discovery motion) that it has
 3 produced to defendants all of the INDs in plaintiff's possession, custody, or control.
 4 *Id.* at 52. Under Rule 26(g)(1)(A), defendants are entitled to such a certification.⁵
 5 Plaintiff appears willing to give such formal assurances. With respect to the NDAs,
 6 defendants seek an order compelling plaintiff to produce the Vitravene and
 7 Kynamro NDAs, as well as any other NDAs similarly linked to plaintiff, or, if none,
 8 a statement in a sworn discovery response unambiguously confirming such. *Id.* at
 9 52-53. Plaintiff contends that further response is not necessary, as it has already
 10 identified the 2 NDAs in its possession or control, that such documents are
 11 publically available, that defendants' request for production of the NDAs was
 12 untimely under the Chamber Rules of Magistrate Judge Crawford, and that the
 13 portion of defendants' request requiring plaintiff to "describe" the documents is
 14 vague and unduly burdensome, as each document totals over 175,000 pages. *Id.* at
 15 53-55. Notwithstanding, plaintiff concedes its willingness to produce the NDAs.
 16 *Id.* at 54-55 (representing to the Court: "[H]ad [defendants] actually requested the
 17 two NDAs, [plaintiff] would also have produced the two NDA documents (each
 18 exceeding 175,000 pages) in its possession, custody, or control.") For the reasons
 19 set forth below, the Court **GRANTS** defendants' request to compel plaintiff to
 20 provide additional responses to Interrogatory No. 7.

21 Based on the arguments presented in the Joint Motion, the content contained
 22 within the INDs and NDAs seems reasonably likely to lead to the discovery of
 23 information relevant to the Safe Harbor issue. Further, the disputes over the INDAs
 24 and NDAs appear to be a matter of form, not substance. As to the INDs, defendants

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 26 ⁵ Under Rule 26(g)(1)(A), discovery responses must be accompanied by a
 27 certification "after a reasonable inquiry" indicating that the disclosure is "complete and
 28 correct as of the time it is made. . . ." While plaintiff provided substantially similar
 assurances in the parties' jointly submitted Discovery Motion, this is not a binding
 discovery response, and thus, is insufficient to satisfy the certification required under
 Rule 26.

1 seek a sworn statement in a discovery response that plaintiff's current production is
 2 complete – a statement plaintiff is willing to give. Regarding the NDAs, defendants
 3 are no longer demanding that plaintiff “describe” the voluminous NDAs; rather, the
 4 most recent demand contained in defendants' portion of the Joint Motion seeks
 5 plaintiff's production of the 2 NDAs, and, any other NDAs similarly linked to
 6 plaintiff in plaintiff's control, or, if none, a sworn statement unambiguously
 7 confirming such. *Id.* at 53, lines 11-13. Setting aside any arguments regarding the
 8 timeliness of defendants' request⁶, plaintiff appears willing to produce the 2 NDAs,
 9 and, in the Joint Motion, represents that there are no other responsive NDAs in its
 10 possession or control. *Id.* at 54-55.

11 Good cause appearing, and because plaintiff represents that it is willing to
 12 produce the Vitravene and Kynamro NDAs and provide the assurances defendants
 13 desire, plaintiff is **ORDERED** to provide additional responses to Interrogatory No.
 14 7. Accordingly, **within 10 days** of issuance of this Order, plaintiff must (1) produce
 15 the Vitravene and Kynamro NDAs; and, (2) provide a Rule 26(g)(1)(A) certification
 16 that the production of INDs and NDAs in this case represents the entire universe of
 17 responsive documents in plaintiff's custody. Specifically, plaintiff's representative
 18

19 ⁶ It is unclear to the Court whether defendants' request for production of the
 20 NDA was timely. Plaintiffs argue that defendants never specifically requested the
 21 production of the NDAs. In contrast to defendants specifically requesting and
 22 engaging in meet and conferrals about the INDs, defendants allegedly did not make
 23 similar inquiries regarding the NDAs. Rather, according to plaintiff, the “only clear
 24 request for information regarding [plaintiff's] two NDAs” was in defendants' last set
 of interrogatories, served via email on March 6, 2013. [Doc. No. 161, p. 55] According
 to plaintiff and based on the FRCP, plaintiff's response to this March 6 request was due
 on April 8, 2013, after the April 5, 2013 discovery cut-off established in this Court's
 Scheduling Order. *Id.*

25 Conversely, defendants contend that production of the NDAs was responsive to
 26 a prior, timely interrogatory served in March 2013 and that May 30, 2013 was the first
 27 time plaintiff had even identified these NDAs. Given that the parties have asked the
 28 Court to decide this (and another) discovery dispute on an expedited basis in
 anticipation of filing a deadline-impacted renewed Safe Harbor MSJ [Doc. No. 155],
 as well as defendants willingness to produce the requested items, the Court will assume
 that the objection was timely filed and refrain from analyzing the timeliness of
 defendants' request.

1 must provide defendants with a written declaration under penalty of perjury
2 detailing their efforts to locate the sought-after items and stating that “to the best of
3 [his or her] knowledge, information, and belief formed after a reasonable inquiry,”
4 the responses to these requests are “complete and correct.” FED.R.CIV.P.
5 26(g)(1)(A). However, the portion of the request seeking a description of the
6 lengthy NDAs is unduly burdensome, and thus, it is **DENIED**. With the production
7 of the NDAs themselves, the Court concludes that this information is equally
8 accessible to both parties.

9 **III. CONCLUSION**

10 For the reasons stated above, plaintiff is not required to supplement its
11 responses to Interrogatory No. 1, but must provide additional responses to
12 Interrogatory Nos. 4 and 7. Accordingly, **IT IS HEREBY ORDERED THAT:**

13 1. **Interrogatory No. 4: Within 30 days** of issuance of this Order,
14 plaintiff must (1) conduct a thorough search and produce any responsive, non-
15 privileged communications from the time period of 2000 to present regarding the
16 scope or application of the Safe Harbor provision as it relates to the ‘199 Patent, and
17 (2) provide a Rule 26(g)(1)(A) certification that the production represents the entire
18 universe of responsive documents in plaintiff’s custody or control.

19 2. **Interrogatory No. 7: Within 10 days** of issuance of this Order,
20 plaintiff must (1) produce the Vitravene and Kynamro NDAs; and, (2) provide a
21 Rule 26(g)(1)(A) certification that the production of INDs and NDAs represents the
22 entire universe of responsive documents in plaintiff’s custody or control.

23 **IT IS SO ORDERED.**

24 Date: July 5, 2013



KAREN S. CRAWFORD
United States Magistrate Judge